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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,539	11/26/2003	Michael E. Natoli	P06681US0	8663

34082 7590 08/25/2005

ZARLEY LAW FIRM P.L.C.
CAPITAL SQUARE
400 LOCUST, SUITE 200
DES MOINES, IA 50309-2350

EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
3728	

3728

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/723,539	Applicant(s) NATOLI	
	Examiner Bryon P. Gehman	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 July 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 3/15/04.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 3-4, "a first and second end walls" is ungrammatical and should be --a first end wall and a second end wall--. In line 4, it is indefinite which antecedent elements "form a hollow...". A comma should appear at the end of line 6.

In claim 9, line 4, "first and a second halves" is ungrammatical.

In claim 14, lines 5 and 7-8, it is indefinite from the antecedent that the housings each have "hollow interiors", only that each housing defines a respective interior.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-3, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (5,826,719). Claims 1-4, 6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pangerc et al. (2004/0256265). Each discloses a container for storing cylindrical items or tools comprising a housing (1; 12; 10; respectively) having a bottom wall (9 or 11; 16; bottom of 66), side walls (as shown; as shown; side parts of 22 and 44), end walls (as shown; as shown; 26 and 28) and an open top (closed by lid 2; closed by lid 11; closed by halves 22 and 44) that form a hollow interior capable of receiving an insert and a retractable door (13 or 20; at 31; 38). An insert (9 or 12 or 18; 20; 18) could it be included and could create a first compartment and a second compartment (on either side of 9 or defined by drawer 12 or the slide frame including trough 19; inside 20 and between 20 and 16; inside 68 and at 64) if so included.

As to claim 2, the insert of each, imaginary or not, could conceivably and inherently receive punches, the actuality again not being claimed.

As to claim 3, the second compartment, imaginary or not, could conceivably and inherently receive dies.

As to claim 4, Banck and Pangerc et al. each disclose a sloped bottom wall (9; bottom of 66) that facilitates unloading of contents to some degree.

As to claim 6, each discloses a pivotal lid (2; 11; 44).

As to claim 8, each discloses the lid with a plurality of recesses (5, 5; as shown; inside 44 and at 54 and at 51).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6 and 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Banck (2,265,336) in view of Mackie (1,955,646). Banck discloses a container for storing cylindrical items comprising a housing (1) having a bottom wall (9 or 11), side walls (as shown), a first end wall (opposite 1 at 3 and 7) and a second end wall (1 at 4 and 8) and an open top (closed by lid 2) that form a hollow interior receiving an insert (open slide frame 17-20), the insert creating a first compartment (between 9 and 17 or between 17 and 18) and defining a second compartment (19) in the hollow interior and a retractable door (20). Mackie discloses a container for storing cylindrical items comprising a housing (1) having a retractable door (8) pivotally connected and positioned on the first end wall of the housing to provide access to the second compartment. To modify the container of Banck employing the pivotally connected retractable door of Mackie would have been obvious in order to provide a more easily closable door than the pushable door of Banck.

As to claim 2, the insert of Banck can inherently receive punches, the actuality not being claimed.

As to claim 3, the second compartment of Banck can inherently receive dies.

As to claim 4, Banck discloses a sloped bottom wall (9) that facilitates unloading of contents to some degree.

As to claim 6, Banck discloses a pivotal lid (2).

As to claim 8, Banck discloses the lid with a plurality of recesses (5, 5).

7. Claims 1-3, 6 and 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (5,826,719) in view of Mackie. Chen discloses a container for storing cylindrical items comprising a housing (12) having a bottom wall (16), side walls (as shown), a first end wall (at 16) and a second end wall (by the hinges) and an open top (closed by lid 11) that form a hollow interior receiving an insert (20), the insert creating a first compartment (between 16 and 20) and defining a second compartment (inside 20) in the hollow interior and a retractable door (at 31). Mackie discloses a container for storing cylindrical items comprising a housing (1) having a retractable door (8) pivotally connected and positioned on the first end wall of the housing to provide access to the second compartment. To modify the container of Chen employing the pivotally connected retractable door of Mackie would have been obvious in order to provide a more easily closable door than the pushable door of Chen.

As to claim 2, the insert of Chen can inherently receive punches, the actuality not being claimed.

As to claim 3, the second compartment of Chen can inherently receive dies.

As to claim 6, Chen discloses a pivotal lid (11).

As to claim 8, Chen discloses the lid with a plurality of recesses (as shown).

8. Claims 1-4, 6 and 8-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Pangerc et al. (2004/0256265) in view of Omata et al. (6,247,595). Pangerc et al. disclose a container for storing cylindrical items comprising a housing (10) having a bottom wall (bottom of 66), side walls (side parts of 22 and 44), a first end wall (28) and a second end wall (26) and an open top (closed by halves 22 and 44) that form a hollow interior receiving an insert (18), the insert creating a first compartment (including 64) and defining a second compartment (inside 68) in the hollow interior and a retractable door (38). Omata et al. disclose a container for storing cylindrical items comprising a housing (A) having a retractable door (50) pivotally connected and positioned on an end wall of the housing to provide access to an inner compartment. To modify the container of Pangerc et al. employing the pivotally connected retractable door of Omata et al. would have been obvious in order to provide a more easily closable door than the slidable door of Pangerc et al..

As to claim 2, the insert of Pangerc et al. can inherently receive punches, the actuality not being claimed.

As to claim 3, the second compartment of Pangerc et al. can inherently receive dies.

As to claim 4, Pangerc et al. discloses a sloped bottom wall (bottom of 66) that facilitates unloading of contents to some degree.

As to claim 6, Pangerc et al. discloses a pivotal lid (44).

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As to claim 8, Pangerc et al. discloses the lid with a plurality of recesses (inside 44 and at 54 and at 51).

As to claim 9, Pangerc et al. disclose a housing insert (60 and 62) including a hollow interior (inside 68) and a top wall having apertures (80) and means (70, 72) for releasably securing the insert within a container. Omata et al. disclose forming a housing from detachable halves to form a hollow interior. To provide the housing of Pangerc et al. in the manner of Omata et al. would have been obvious, as housings formed in such a manner are common and the provision fails to distinguish any new and unexpected result.

As to claim 10, the apertures of Pangerc et al. each have a keyed entry for particular contents and sloped portions (at 82).

As to claim 11, each aperture of Pangerc et al. is inherently adapted to receive a desiccant tablet.

As to claim 12, each aperture of Pangerc et al. has support members (82).

As to claim 13, Omata et al. disclose latches (22 and 42) to join the halves together.

9. Claims 5 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 6 above, and further in view of Huot Jr. et al. (6,206,189). Huot Jr. et al. disclose providing a housing of translucent material. To modify the housings and lids of any one of Banck, Chen and Pangerc et al. from

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translucent material would have been obvious in view of Huot Jr. et al. in order to allow viewing of the interior of the housing from the outside.

10. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banck in view of Mackie (1,955,646) and Blasko et al. (5,228,590). Banck discloses a housing having a hollow interior, an insert (17-20) disposed within the hollow interior to create a first compartment (between 17 and 18) and defines a second compartment (at 19). Banck discloses the claimed individual housing except for a retractable door pivotally connected to an end wall of each housing. Mackie discloses a housing with a pivotally connected retractable door (at 8 and 10). To substitute the door of Mackie for the door (20) of Banck would have been obvious in order to facilitate access to the interior of the housing in the manner suggested by Mackie. Blasko et al. disclose detachably connecting a plurality of dispensing housings to one another. To modify the housing of Banck in the manner disclosed by Blasko et al. to form a container of housings would have been obvious in order to provide plural dispensers in a single unit, as suggested by Blasko et al..

As to claim 15, to provide a handle on the container would have been obvious in order to facilitate carrying of the container, such being given as official notice as being within the level of ordinary skill in the art.

As to claims 16 and 17, Blasko et al. disclose a clasp and slot arrangement (see column 4, lines 30-36).

As to claim 18, Blasko et al. further disclose notches (30) to receive a protrusion ((22f, 28f).

11. Applicant's arguments filed July 11, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that Omata et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem is providing an alternative door for the slidable door of Pangerc et al. The pivotable door of Omata et al. has the advantage of not being entirely removed and possibly separated from container, while the Omata et al. door will not, as well as the door being easier to open and close. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been shown that to provide a hinged door to the container of Pangerc et al. has advantages, those advantages being obvious to one of ordinary skill in the art. In response to applicant's argument that the examiner's

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conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Each of the base references provides a door, to substitute a different but known door falls with the purview of obviousness under 103.

With respect to the Pangerc et al. reference, since it is shown how to put the elements together to integrate the elements of the container, those steps can obviously be reversed to deconstruct the same container to its component parts. There is no disclosure that Pangerc et al. is permanently and irreversibly disposed in its condition of Figure 1, and that would required for the insert to be not "releasably secured" as much as claimed.

With respect to Banck, Mackie and Blasko et al. being nonanalogous, it should be noted that each pertains to a container for dispensing cigarettes, less particularly cylindrical articles. It is supposed that cylindrical punches and dies could be dispensed in the same manner as the cigarettes of Banck, Mackie and Blasko. Since applicants' claims are only imagining possible contents, the question is not what the structure does, but what it could do. In the examiner's opinion, the proposed combination can inherently contain punches and dies and to actually do so would have been obvious in order to

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derive the storage and dispensing advantages recognized by each of Banck, Mackie and Blasko for cylindrical articles in general.

With respect to applicants' argument that the differences between Mackie and Banck (or Chen) "teach away" from making the combination, such is not seen to be the case when considered by one of ordinary skill in the art. For example, a house wall without a window would "teach away" from putting a window in that wall, but one of ordinary skill in the art would obviously make a window in the wall if he wanted to be able to see through the wall, or have air current advantages, or sunlight advantages, etc.. The structure being different does not teach away from a combination just because they are different.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

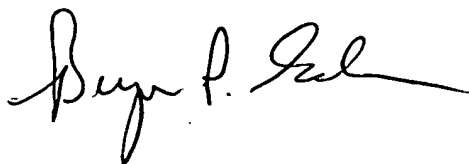
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 271-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 271-4562. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG